

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

APPLICANT(s): Jonathan D. Levine

SERIAL NO.: 10/041,081 ART UNIT: 2178

FILING DATE: January 7, 2002 EXAMINER: Cesar B. Paula

TITLE: SYSTEM HAVING A SINGLE, ROBUST, UNIVERSAL  
WORKFLOW FOR THE CREATION, PRINTING, AND BINDING  
OF HARDCOPY BOOKS, AND FOR THE ACCESSIBILITY AND  
DELIVERY OF ELECTRONIC BOOKS

ATTORNEY D/A1202,690-010417-  
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**RESPONSE TO NOTIFICATION OF NON COMPLIANT APPEAL BRIEF**

(37 C.F.R. §1.192)

This is in response to the Notification of Non-Compliant Appeal Brief mailed February 5, 2008. This is an appeal from the final rejection of the claims in the subject application mailed June 22, 2007. A Notice of Appeal was filed on September 24, 2007. A Notice of Panel Decision from Pre-Appeal Brief Review was mailed December 13, 2007. An Appeal Brief was filed on January 14, 2008.

**Remarks**

Sections 6 and 7 of the Appeal Brief are amended according to the attached.

**[6] Grounds for Rejection to be reviewed on Appeal**

- A. Applicant requests that the grounds, for making the rejections of the Office Action of June 22, 2007 final, be reviewed.
- B. Applicant requests that the grounds for refusing to enter the amendments to the claims, in particular the amendment to claim 20, be reviewed.
- C. Applicant requests that the grounds, for each rejection of claims 1-38 under 35USC 112, first paragraph, based on failure to provide a written description, be reviewed.
- D. Applicant requests that the grounds, for each rejection of claims 1-38 under 35USC 112, first paragraph, based on failure to provide reasonable enablement, be reviewed.
- E. Applicant requests that the grounds, for rejection of claims 1 and 20 under 35USC 112, second paragraph, based on failure to particularly point out and distinctly claim the subject matter of the invention, be reviewed.
- F. Applicant requests that the grounds, for rejection of claims 1-3, 9-22, and 28-38 under 35USC 103(a), based on the combined teaching of the references Warmus, et al and Dodge, et al, be reviewed.
- G. Applicant requests that the grounds, for rejection of claims 4-8, and 23-27 under 35USC 103(a), based on the combined teaching of the references Warmus, et al and Dodge, et al and further in view of Dickmeyer, et al, be reviewed.

## **[7] Argument**

A. In the office action of June 22, 2007, rejecting the claims, the examiner cited, for the first time, the reference Dodge, as a basis for new obviousness rejections. The citation of this new reference was not necessitated by Applicant's prior amendments, but by the acknowledgement by the Examiner of the deficiencies of the reference Warmus. Accordingly, the issuing of a final rejection is improper under MPEP section 706.07(c) where it is stated:

**"While the rules no longer give to an applicant the right to "amend as often as the examiner presents new references or reasons for rejection," present practice does not sanction hasty and ill-considered final rejections. The applicant, who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his or her application."**

Applicant submits, that the office action should not have been designated as final, thereby permitting Applicant to amend the claims in response to the newly cited reference.

B. In the response of August 22, 2007, Applicant amended the claims to clarify the novel features of the invention for which protection is sought in this application in response to Examiner's comments in the Office Action of June 22, 2007. In particular the claims were amended in response to the rejection under 35USC112 and to support Applicant's arguments distinguishing the newly cited reference Dodge. These amendments were submitted after final rejection in order to place the claims in condition for allowance or in the alternative to place the claims in better condition for appeal. Applicant submits that such amendments were properly presented under 37USC1.116 and should have been entered in order to advance the prosecution of the application.

In particular, Applicant amended independent claims 1 and 20 to further clarify what is meant by solution-independent intermediate format, devoid of said particulars unique to the "originating software, hardware, and operating system". Applicant submits that this language removed the issues raised by the Examiner and were consistent with other claims and the specification. No new matter was presented. In addition claim 20 was amended to correct a word processing error discovered by Applicant. This error rendered the substance of the claim unclear and inhibited meaningful prosecution of the claim. Applicant's amendment to claim 20 should have been entered under 37USC1.116.

C. Claims 1-38, and in particular independent claims 1 and 20 stand rejected under 35USC 112 first paragraph. The Examiner indicates that Applicant has failed to provide a written description of "said digital structure and codes are devoid of said particulars [unique] to the needs of the originator". In paragraph 0004 of the published application, Applicant discusses the reason for the basic incompatibilities of master book files as follows:

**"These problems have been observed even when the original content provider and the reproducing entity employ the same basic book publishing software, since the software has often been modified to fit the needs and eccentricities of the particular user, and the files often contain formatting unique to the particular user. The differences in book reproduction workflows are often unintentional, but rather, the result of independent development and modification in response to the environment and demands of the particular user."**

A person skilled in the art would recognize the above excerpt as describing the digital structure and codes unique to the originator. In the particular, in the limitation of claim 1, there is described a conversion of the original book file to a file that is devoid of the modifications to the original software. As indicated above, these modifications were needed to suit the needs of the originator. Applicant submits that a person skilled in

the art would understand, from the positive description of what is present in the book file, that which is claimed to be absent from the converted book file as claimed by Applicant. It is well settled that the purpose of the written description requirement is to insure that the Applicant had in its possession that which is claimed as an invention. Applicant submits that the disclosure of this application fulfills the written description requirement of the 35USC112, first paragraph.

D. The Examiner also rejects claims 1-38 for failing to reasonably provide enablement for "said digital structure and codes are devoid of said particulars to the [unique} needs of the originator". Applicant submits that the above remarks show the description of this feature. The Examiner indicates, in this regard, that the specification of a universal format **devoid of digital structure and codes particular to the needs of the originator is not found.** In paragraph 0014 of the published application states as follows:

**"With reference to the description, infra., it should be noted that the software used for general book publishing can be one or more of a number of commercially available ones. These include such software packages as Adobe Systems' PostScript.TM. and PDF.TM., and many others."**

Applicant submits that it is sufficient to provide the features of the software "the digital structure and codes", as indicated above, in order to enable the removal of these features. A person skilled in the art would recognize how to make and use the subject matter of the invention as described in claim 1.

It is the nature of the system and method of this application, that an original book file be established as a starting point. In the Background of Related Art section of this application, it is stated as follows:

**"One noticeable problem with prior art print-on-demand book publishing methods is that while master book files created by one particular publisher/content provider**

**can be efficiently reproduced as books by the same entity because the software has been designed for the particular needs of the content provider, the master book files may not be efficiently reproduced by another entity.” (page 1, line 24 to page 2, line 3)**

Accordingly, the starting point is the master book file, and, it is created by one particular publisher or content provider. It would be clear to a person skilled in the art that the problem arises subsequently, when the master book file is sought to be used by another entity. The starting point may be reasonably described as created, by an originator or original content provider. This is evident throughout the application. Attention is directed to, for example, page 2, line 6 and in particular block 104 of figure 4. The original master book file is stated to have software characteristics “designed for the particular needs of the content provider”. This content provider constitutes the originator. A person skilled in the art would understand that such software characteristics would accurately include, “a digital structure and codes of an originating software, hardware, and operating system” and further that such digital structure and codes of an originating software, hardware, and operating system, may also include particulars “unique to the originating software, hardware, and operating system”. It is these particulars that hinder the use of the original master book file by subsequent publishing entities. It is submitted that the reference to “Administrator of the system” in the specification refers to the administrator of the system **for the original content provider.** The specification fully enables a person skilled in the art to understand that the administrator of the system, as specified in the description, is one and the same as the “originator”, as specified in claim 1. It is well settled that the statement of a limitation may enable one skilled in the art to make and use the claimed invention even though that the statement of the limitation is not contained in the specification (see MPEP2164). Applicant submits that, in this instance, the stated limitation is implied throughout the specification and therefore is actually contained therein.

E. The examiner has applied the same premise to support a rejection of claims 1 and 20 for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, namely, that the claims specify the "originator" while the specification indicates the "administrator of the system". It is unclear what the Examiner perceives to be the difference. Reading the specification as whole and not just page 5, lines 11-12, it is clear, as indicated above, that there is a book file that provides the starting point of the method of this application. This book file clearly and logically may be referred to as the original book file to which the conversion of the method may be applied. Taking this one step further, there must be an originator of the original book file. The claim limitation is, therefore, fully described and enabled in the specification and claim 1 fulfills the requirement for distinctiveness.

F. Claims 1-3, 9-22, and 28-30 are rejected under 35 USC 103(a) based on the combined teaching of the reference Warmus in view of the newly cited reference Dodge. This rejection is traversed on the following grounds:

The combined teaching of Warmus and Dodge does not render Claims 1-3, 9-22, and 28-30 obvious because it fails to teach or otherwise suggest each and every limitation of the claims. It is well settled that in order to establish a prima facie case for obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, without reference to the disclosure of this application. (MPEP Section 2142) ***In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria."**

In particular the combined teaching fails to disclose or suggest the claimed features of independent claim 1 as stated below:

in claim 1:

**"b) converting said complete book file to have a solution-independent, intermediate format, in a universal format, wherein said digital structure and codes are devoid of said particulars unique to the needs of the originator ;**

**c) storing said solution-independent, intermediate formatted book file along with book identification information as a mastered book;**

**d) converting said solution-independent, intermediate formatted book file to a solution-dependent formatted book file to match the needs of a particular book reproduction system;**

Claim 20 is intended to have equivalent language.

The Examiner acknowledges that the reference Warmus fails to disclose:

**"converting said complete book file to have a solution-independent, intermediate format, in a universal format, wherein said digital structure and codes are devoid of said particulars unique to the needs of the originator digital structure and codes of an originating software, hardware, and operating system."**

This statement appears to be in conflict with the statement in the last paragraph on page 5 of the Office Action, it is assumed that the conflicting paragraph is an artifact of earlier office actions and was meant to be deleted.

The Examiner continues to indicate that the files of Warmus start with an original file wherein "said original digital structure and codes includes particulars unique to the needs of the originator". This is an assumption by the Examiner, as there is nothing in Warmus that states this. This is because the original digital structure is irrelevant to the purpose of Warmus. Warmus is directed only to textual content. This assumption is an effort by the Examiner to support the impression that Warmus is directed to solving a problem similar to the problem to which this application is directed. The assumption is not correct. The problem to which Warmus is directed is a page file problem dealing with textual content and treats the textual files on a page by page basis, whereas the solution of the subject invention relates to digital platform of the entire book file. Warmus results in the customization of individual pages of a book during printing of multiple copies. In the system of this invention, all of the pages are processed in the same manner, with respect to content, while the entire book file may be transferred

and converted to accommodate solution, or platform, or device dependent needs of a particular publisher.

The nature of the stripped working files of Warmus is explained at column 11, lines 10-29, as follows:

**"A further set of working files is stripped of all fixed information to create stripped variable page files 126 defining template pages having fixed information removed therefrom and further having the area data defining the areas 110, 112. The data representing template pages having variable information thereon are expanded into a set of intermediate page files. In the example of FIGS. 6a and 6b and under the files 130, 132 are thus produced. The file 130 includes a file portion P1-a defining the position of variable information to be produced on the page P1 for the first book. Two other file portions P1-b and P1-c define the position of variable information to be produced on the front outside covers of the remaining two books. In like fashion, file portions P4-a, P4-b and P4-c represent the position of variable information to be reproduced on the back outside covers of the three books. At this point, data is also contained in each of the files 130, 132 identifying the entries in the database 108 to be placed in the areas 110, 112 during printing."**

There is no reference to changing digital structure and codes of an originating software, hardware, and operating system. The processing of the page files of Warmus causes an entirely different result than the processing of the book files in this application. The reference Warmus designates a fixed text file and variable text files wherein the variable text file may be altered. It relates to text files not digital structure and codes.

The deficiencies of the teaching of Warmus are therefore greater than the Examiner indicates and these deficiencies are not remedied by the teaching of Dodge.

Dodge teaches that, by using object oriented information management methods, a document database may be partitioned into a number of encapsulated data elements, that are classified and tagged. The document database may then be filtered and formatted to form variation specific documents (see column 4, lines 8-29 and figure 2 of Dodge).

The document database is a compilation of documents suitable for different platforms. It, therefore, contains all of the software and digital codes of the originating content provider including any particulars unique to the originator and further includes all of the digital structures for other possible platforms (see column 6, lines 43-56). It does not convert an original, master book file into a solution independent intermediate format, but instead creates a database in which elements of the book information are identified, tagged and classified to enable the compilation of different versions of the book file suitable for a particular platform. This is the opposite of the stripped down book file into which the master book file of this application is converted. The book file of Dodge is described at column 7, lines 21-32, as follows:

**"An information data model is a conceptual aid used to describe information stored in a database. In the CDS information data model, the data for a particular document is stored in a database as encapsulated data elements. An encapsulated data element is an object that contains two kinds of information: 1) The information itself (such as an actual paragraph, table, or graphic), and 2) Classifying data about that information, including its structure (such as the fact that it is a paragraph structure or table structure) and which class or variation the information applies to. These encapsulated data elements can then be combined in a number of variation-specific documents."**

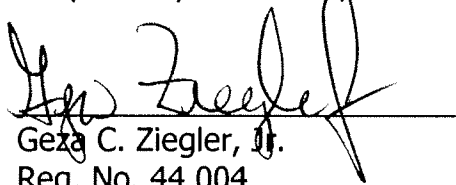
The combined teaching of Warmus and Dodge, therefore, fails to teach the elements of the claims identified above. Dodge fails to remedy the deficiencies of Warmus. The combined references do not therefore support a prima-facie case of obviousness. The modification of the teachings of Warmus and Dodge, in order to obtain the invention, as described in the claims submitted herein, would not have been obvious to one skilled in the art. These grounds apply equally to the rejected dependent claims, all of which, by dependency, have the limitations described in the independent claims 1 and 20. None of the cited references remedy the deficiencies of the combined teaching of Warmus and Dodge.

G. Claims 4-8, and 23-27 stand rejected under 35USC103(a) based on the combined teaching of Warmus in view of Dodge and further in view of Dickmeyer et al, U.S.

Patent No. 6,413,100. This rejection is traversed on the same grounds as indicated above with respect to independent claims 1 and 20. The reference Dickmeyer et al fails to remedy the deficiencies of the combined teaching of Warmus and Dodge.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 24-0037.

Respectfully submitted,

  
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